SUPREME COURT, U. S.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1968.

No. 1355

BLUMCRAFT OF PITTSBURGH, a Partnership Consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioners,

vs.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC. and COLONIAL IRON WORKS, INC.,
Respondents.

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Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

I

OPINIONS BELOW

The opinion of the Court of Appeals for the Fourth Circuit, of which review is sought (now officially reported at 407 F.2d 557 (1969)) and the judgment of that Court is reprinted in the Appendix to the Petition.

The opinion of the United States Court of Claims (372 F.2d 1014 (1967)) relating to but one of the patents here in issue is also included in Petitioner's Appendix.

II

JURISDICTION

The jurisdictional requisites are adequately stated in the Petition.

III

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

This case involves Article I, Section 8, Clause 8, of the Constitution, and Sections 103 and 171 of the Patent Code, 35 U.S.C. §§103 and 171.

CONSTITUTION

Section 8. The Congress shall have Power * * *

8. To promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive right to their respective Writings and Discoveries;

PATENT CODE

§103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§171. PATENTS FOR DESIGNS

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided. (Emphasis added).

IV

ISSUES PRESENTED BY PETITION

Both of the patents in suit, one a design patent (which expired April 20, 1968) and the other a mechanical patent, relate to handrails although to different handrails. A single type of handrail used by defendants (Respondents herein) and unlike either of those shown in the patents was accused to infringe both.

It is of course recognized that the origin of handrails is so far removed in history that it is beyond exact documentation. Balconies and stairways have long been provided with handrails for protective purposes.

Handrails, even from the earliest times have been provided with certain conventional and necessary parts including spaced, upright posts supporting one or more railings by suitable fasteners. These handrails assemblies were necessarily fashioned to conform to the contour of the balcony or stairway on which they were mounted. Walls adjacent the steps of a stairway have similarly long been provided with handrails mounted on brackets attached to the wall surface.

Notwithstanding the crowded state of the railing art, actually going back as far as memory serves, Louis Blum, the patentee of both of the patents in suit, as late as 1953 declared himself to be the inventor of a railing design, and in 1955 the inventor of a mechanical gadget in another type of railing for attaching the handrail to the posts.

As became apparent from the institution and unfolding of this litigation, Blum considered himself to be the "in-

ventor" of far more than the specific structure shown and described in his patents.

The real questions for consideration therefore are:

a) Did the Court of Appeals commit gross and manifest error in holding the patents in suit invalid under 35 U.S.C. §103 as heretofore interpreted by this Court after careful application of each and every one of the tests for obviousness or non-obviousness of the alleged inventions as it was obliged to do in accordance with the precepts of this Court in *Graham* v. *John Deere Co., et al.*, 383 U.S. 1 (1966).

b) Was the Court of Appeals clearly wrong in reaching its own independent judgment on the validity of the design patent under the mandates of this Court as it was obliged to do notwithstanding the fact that the patent had been held valid in a previous decision of the Court of Claims, where not all of the pertinent prior art was before the Court of Claims and where after trial of the action before the Trial Commissioner, the government, in consideration for a favorable limitation of its potential liability, agreed not to take exception to the Trial Commissioner's findings of validity, thus leaving the government unrepresented before the full Court of Claims and paving the way for the Judges of the Court to grant plaintiff's Motion for Judgment on the record?

c) Did the Court of Appeals use unsound judgment in holding both patents in suit invalid as not meeting the exacting standard of invention that is required by this Court in order to justify the imposition of a patent monopoly on the public, where

1) The design patent, merely showing a railing made up of spaced posts supporting a plurality

of handrails through use of L-shaped brackets, was held invalid because it would have been completely obvious to skilled railing designers in view of similar showings in the prior art to simply support the rails from posts by somewhat inconspicuous brackets; and

2) The mechanical patent relating simply to a railing made up of an ordinary post, a dovetail handrail, and a two-piece clamp supporting the handrail from the post and gripping the base of the handrail was held invalid, not only because the assembly is nothing more than a conventional vise, but also because the prior art showed handrails offset from posts, as well as two-piece V-shaped clamps connected to a post and gripping the dovetail base of a rail?

V

COUNTER STATEMENT OF THE CASE

Blumcraft of Pittsburgh brought this action for patent infringement on September 27, 1962, in South Carolina against defendants located and doing business in that area, well knowing that they were simply customers of Architectural Art Mfg., Inc. of Wichita, Kansas, the manufacturer of the accused railing structure.

Defendant Citizens and Southern National Bank of South Carolina is the owner of the bank building in Greenville in which the accused railing was installed; defendant Daniel Construction Co., Inc. was the general contractor for the bank building; and defendant Colonial Iron Works, Inc. fabricated and installed the components purchased from Architectural Art, under subcontract from Daniel.

Architectural Art has controlled and conducted the defense of this suit but has never been a party.

After bringing this action, Blumcraft brought suit against the United States in the Court of Claims on February 12, 1963, for infringement of the design patent *only*. The government was alleged to have infringed the patent by its purchase and use of certain handrails made by Railcraft Corporation of San Francisco, California. There was not then and has never been any connection between Railcraft and Architectural Art. The Railcraft railing accused in the Court of Claims suit was completely different from the Architectural Art Clean Line railing involved in this suit.

The Justice Department, defending the Court of Claims suit on behalf of the government, assigned the case to a junior attorney in the Patent Section. In preparation for trial, he asked the defendants in South Carolina for an identification of the prior art developed in connection with their defense. In answer to the specific request of the Justice Department, Respondents identified the prior art located up to that time, as they felt they were bound to do so.

This was the full extent of the so-called "direct collaboration" between Respondents and the government in the Court of Claims suit which Petitioner relies upon as being so important in confirming that there is a controlling relationship between the Court of Claims action and this suit.

When it became apparent to Blumcraft that trial of the Court of Claims action could be commenced before trial in South Carolina, notwithstanding earlier filing of the District Court case, Blumcraft made every effort from that point on to delay trial of the case in South Carolina until after the decision of the Court of Claims. In fact, Blumcraft filed a motion which was granted by the District Judge to hold up the South Carolina trial until after de-

cision by the Court of Claims, even though there was no relationship whatsoever between the actions, and the South Carolina case at that time had been on file for well over three years.

The Trial Commissioner of the Court of Claims issued an opinion on September 22, 1966 recommending that the design patent in suit be held valid and infringed. Blumcraft then offered to limit the recovery sought from the government if the Department of Justice would agree not to take exception to the Commissioner's recommendations or present any argument to the full Court of Claims in disagreement with the findings of the Trial Commissioner. The government accepted Blumcraft's offer and presented no argument or opposition to the ruling by the Commissioner. As a consequence, the Court of Claims issued its per curiam opinion on February 17, 1967, adopting the Commissioner's recommended findings and conclusions with the notation that the government had not opposed or taken exception thereto. (Opinion, Pet. A. p. 57a).

The South Carolina case finally went to trial on May 17, 1967, and the District Judge held both patents in suit valid and infringed in an opinion dated May 23, 1968, noting that the prior opinion of the Court of Claims had been persuasive (Opinion, Pet. A. p. 14a) in concluding that the design patent in suit was valid over the prior art.

Defendants actively prosecuted an appeal of the District Court's decision to the Fourth Circuit Court of Appeals, and the lower court's decision holding the patents in suit valid was unanimously overruled. (Pet. A. p. 47a).

The Mechanical Patent (No. 2,905,445)

The extremely simple rail structure of the mechanical patent in suit may be fully understood from the showing in Figures 1 and 3 of the patent reproduced below:

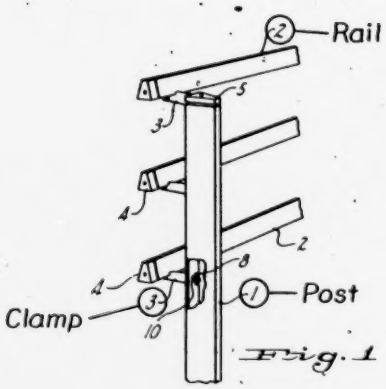


Fig. 1

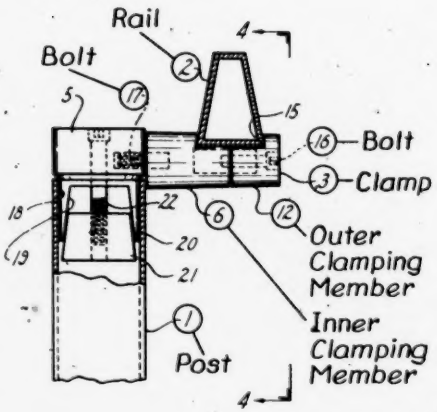


Fig. 3

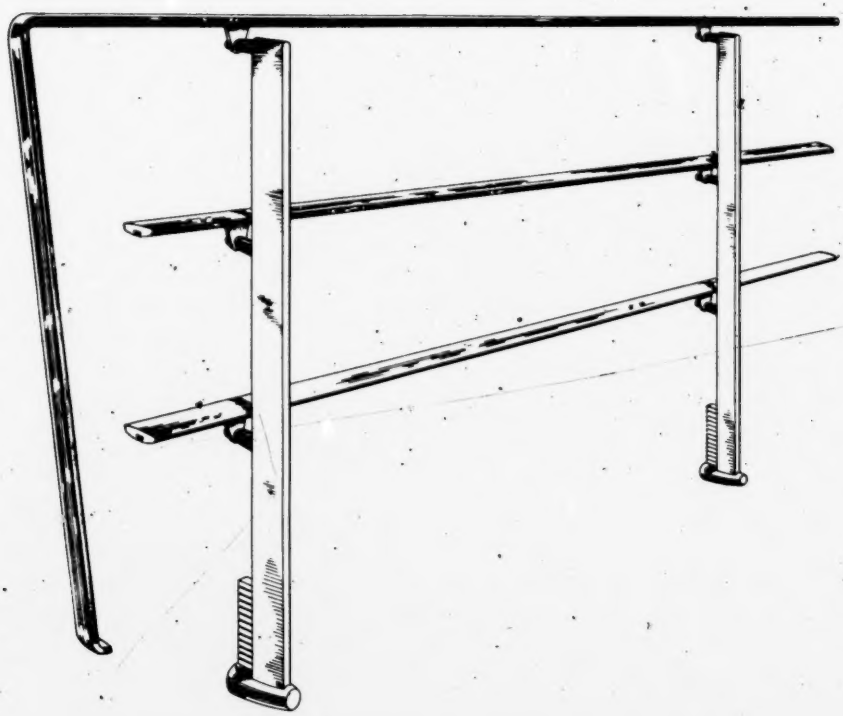
The trapezoidal rails 2 are held offset from the post 1 by simple brackets or clamps 3 (Fig. 1).

As shown in Fig. 3, each clamp 3 is made up of inner and outer clamping members 6 and 12 which quite naturally have V-notches shaped to receive the dovetail base of rail 2.

The inner clamping member 6 is attached to the post 1 by an ordinary bolt 17, and another conventional bolt 16 passing through the outer clamping member 12 and threaded into inner clamping member 6, merely causes the members 6 and 12 to grip the rail 2 as in a common vise.

The Design Patent

The single figure of the design patent in suit is reproduced below:



Basic to railing structures generally in the above assembly is a number of rails extending from one post to another. The rails are supported alongside the posts by L-shaped brackets, and the top rail has a downwardly and inwardly inclined end extension.

The posts are merely rectangular bars modified only by bullet shaped feet and by ribbed shanks on their inner edges adjacent the feet.

The rails consist simply of long, generally flat bars with slightly curved gripping surfaces. The brackets include nothing more than outwardly projecting rods carrying rail supporting triangular plates.

The single claim of the patent is for a rail "as shown".

In an effort to support its contention of infringement, and faced with a marked difference in appearance between the accused railing and that shown in the design patent, Blumcraft took the position in this litigation that many of the components shown in the patent drawing should actually be ignored as not being a part of the design.

These include the downturned extension of the upper rail, the bullet shaped feet on the posts and the serrated shanks above the feet. The specific shapes of the rails and posts as illustrated were also argued to be unimportant.

VI

ARGUMENT

The Court of Appeals Fully Met Its Duty of Ruling on the Validity of the Design Patent in Suit under the Strict Mandates of This Court, Rather Than Simply Resorting to "Comity" As a Basis for Holding It Valid As a Matter of Expediency

Faced with the obligation of either following the rules and principles laid down with repetitious uniformity in the judicial pronouncements of this Court, or to courteously recognize and follow the findings of the Court of Claims on the basis of comity as a matter of expediency, the Court of Appeals below on its own determination held the design patent in suit invalid as obvious under 35 U.S.C. §103 and under the high standard of invention required by this Court as a condition to patentability.

Pages 11 to 16 of the Petition contain a long and belabored treatise as to why the Court of Appeals should have followed the decision of the Court of Claims on the basis of "comity". Respondents of course recognize that comity has a place in the law to avoid repeated litigation

of a single matter and to obtain uniformity of decision. However, comity is not a matter of common law or statute but simply deference by one court to the opinion of another out of respect. It can never be applied in opposition to the dictates of this Court.

The doctrine of judicial "comity", particularly in the case of patents where the rights of the entire public are involved, cannot and must not be permitted to serve as a substitute for the absolute and unavoidable obligation on each lower court considering the validity of a patent, to make unquestionably certain in each instance that the subject matter of the patent does in fact meet the high standard of invention uniformly required by the decisions of this Court under the Statutes and the Constitution.

Blumcraft, citing *Mast, Foos & Company* v. *Stover Manufacturing Company,* 177 U.S. 485 (1900), contends that under the doctrine of judicial comity, it was error for the Court of Appeals to reach an independent conclusion on the validity of the design patent, since the Court of Claims had previously held the patent valid.

Not only is Blumcraft's contention contrary to the public interest, particularly where the first court did not have before it all of the prior art made available to the second court as is the case in this suit, but *Mast, Foos* simply does not support Petitioner's argument.

In that case, precisely as here, the Eighth Circuit had previously held the patent in suit valid, while the Seventh Circuit reached an independent subsequent conclusion that the patent was invalid, reversing the trial court which had relied on the Eighth Circuit decision case.

This Court endorsed the independent action of the Seventh Circuit Court of Appeals and made it clear that ". . . the primary duty of every court is to dispose of cases

according to the law and the facts; in a word, to decide them right. In doing so, the Judge is *bound* to determine them according to his own convictions." (loc. cit. p. 488, emphasis added).

Nothing can be gained by Certiorari in the instant case merely to reiterate the law of comity as set down by this Court in *Mast, Foos & Company* v. *Stover Manufacturing Company*, supra.

Patents, as creatures of statute only, as opposed to matters of natural right, must be treated as requiring a very high level of innovation and invention for support, since they inherently impose a limitation not only on the parties involved in a particular suit, but the public right as well, all to the benefit of the patentee alone.

This Court just recently acted on the standard of invention required to justify a patent monopoly in *Graham* v. *John Deere Co., et al.*, supra, 383 U.S. 1 (1966), holding that Section 103 of the Patent Act does accurately reflect a controlling precept of patentability under the Constitution. Mr. Justice Clark, in his historical review of the strictures which have been placed on patent monopolies by this Court under the Constitution and Statutes from the very beginning of the patent system in this country, makes it abundantly clear that a precise demarcation must be drawn between "the things which are worth to the public the embarrassment of an exclusive patent, and those which are not." (loc. cit. p. 9). The courts below were admonished that they should beam attention with greater intensity on the requirements of Section 103 of the Patent Act and that the Statute did not in any way change the "general strictness with which the overall test is to be applied". (loc. cit. p. 19).

The tests for determining obviousness or non-obviousness of an invention were set down with clarity and

precision in the *Graham* decision, leaving no room for doubt or argument as to their import or meaning.

The primary tests were listed as: what was the state of the prior art; what were the differences between the alleged invention and the art; and what was the level of skill in that field. This Court said that secondary considerations such as long felt need and commercial success could be looked to for enlightment on the origin of the development, but could not be used to tip the scales of patentability, regardless of their nature, where there was no invention under the primary guidelines.

In this case, the Court of Appeals scrupulously adhered to the requirements of *Graham*, making conclusive determinations on each of the primary tests and giving full consideration to the secondary factors raised by the plaintiff. With these conclusions before them the Court was forced to find the design patent invalid.

Thus, the Court of Appeals cannot be criticized for failing to follow the legal obligations imposed upon it by this Court under the Patent Statute and the Constitution, but may be brought to task, if at all, only by a showing of clear and manifest error in holding the design patent invalid under Section 103 and the decisions of this Court.

This Court has repeatedly held that certiorari is not appropriate for use by a defeated litigant merely to obtain a second appellate review of his case. See, as one example among a multitude, *Magnum Import Co.* v. *Coty*, 262 U.S. 159, 163 (1923). Certiorari is granted only when principles of public importance require resolution rather than the mere interests of the litigants. *Forsythe* v. *Hammond*, 166 U.S. 506, 514 (1896); *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al.*, 261 U.S. 387, 393 (1923); and *Rice* v. *Sioux City Memorial Park Cemetery*, 349 U.S. 70, 74 (1955).

Furthermore, and contrary to Petitioner's position, since the scope, meaning and applicability of Section 103 of the Patent Statute were all firmly resolved in the *Graham* case, these questions do not need reexamination here. No one can seriously question the applicability of Section 103 to design patents, *as specifically provided by 35 U.S.C. §171,* since all patents, mechanical and design alike, are granted under the same constitutional authority.

The Decision of the Court of Appeals Is Not in Such "Conflict with the Decision of the Court of Claims As to Justify Review under Rule 19

Manifestly, Petitioner is unable to justify review of the Court of Appeals decision on the basis of conflict of decisions as to the mechanical patent in suit because it was not involved in Blumcraft's suit against the government. The validity of the mechanical patent was tested for the first and only time in the present case.

As to the design patent, in view of the actual circumstances which occurred in connection with such patent being held valid in the Court of Claims, it is submitted that the ruling of the Court of Claims should not and cannot, under any standard of measurement, be considered as equal to that of the Court of Appeals in this suit.

Respondents do not argue that decisions of the Court of Claims are not normally on much the same judicial level as those of the Courts of Appeal, but insist that in this particular circumstance, the ruling by the Court of Claims on the design patent cannot be considered to have been reached on a basis equivalent to that of the Court of Appeals below. There is in fact no "real and embarrassing conflict of opinion and authority between Courts of Appeal". *N.L.R.B.* v. *Pittsburgh S.C. Co.*, 340 U.S. 499, 502 (1951), citing *Layne & Bowler Corp.* v. *Western Well Works*, 261 U.S. 387, 393 (1923).

Two important and controlling considerations apply: First, there was no appeal involved in the Court of Claims suit. Secondly, the Trial Commissioner in the Court of Claims did not have before him much of the prior art on which the Court of Appeals concluded that the design patent was not patentable.

Where the Trial Commissioner, based only upon the evidence before him, recommended that the design patent be held valid and infringed, and Petitioner then offered to limit the liability of the government under the patent if it would refrain from taking exception to the Trial Commissioner's report, and not oppose Petitioner's motion for judgment on the record, no direct conflict can be found.

In vivid contrast, Respondents submitted all pertinent evidence in the proceedings below and demonstrated conclusively to the Fourth Circuit Court of Appeals that the design patent should be held invalid.

An important reason why the Court of Appeals reached a conclusion on the validity of the design patent different from that of the Trial Commissioner of the Court of Claims was the fact that less than half of the prior art cited by Respondents in this case against the design patent was brought to the attention of the Trial Commissioner. In fact, of the seven specific prior art references referred to in the opinion of the Court of Appeals as being important to show invalidity of the design patent (Opinion, Pet. A, pp. 48a, 49a), only four were of record as prior art in the Court of Claims action. These significant omissions included the Hollaender stair rail which shows it to be old to provide multiple, parallel rails offset from supporting post structure through use of L-shaped brackets. The Court of Appeals also specifically cited a prior disclosure of flat handrails carried by inconspicuous L-shaped brackets in a W. T. Grant store, and prior art showing rails floating away

from their supports in a sanatorium. These were highly important to Respondents' defense and were not before the Trial Commissioner.

The lack of a "real and embarrassing" conflict between the decisions is patently clear; and there is absolutely no justification for a review of the decision below on the grounds of "comity" advanced by Petitioner.

This case is a prime example of precisely why there is no statute on comity, particularly in patent cases. Where would the public be if a patentee could bring a suit in a first court, then before going to trial file suit under the same patent in a second court, take steps to quickly try the case in the second court so that the second defendant would not have time to fully develop its defenses, obtain a favorable decision on validity in the second court, and then in consideration for limiting the recovery, obtain the second defendant's agreement not to appeal so that the decision of validity would be binding on the first defendant under a doctrine of federal "comity"? The question answers itself. But this is exactly the possible result of Petitioner's proposition on comity—as demonstrated by the circumstances of the present case.

"Obviousness" Is the Only Issue Involved in This Case Whereas Unpatentable Aggregation Is the Sole Question Presented in the Pending Anderson's-Black Rock, Inc. v. Pavement Salvage Company, Inc. Case

Petitioner advanced no basis or reason for its request that this case be set for hearing following *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Company, Inc.*, certiorari granted March 24, 1969, Case No. 1014. Other than the fact that both cases involve patents, there is no relationship whatsoever between them. The subject matter, issues presented, and parties are completely different.

The only real question for consideration in this case is whether or not the Court of Appeals faithfully followed the mandate of this Court in *Graham* v. *John Deere Co., et al.*, supra, 383 U.S. 1 (1966), in determining that the subject matter of the patents is obvious in view of the prior art. The issue of obviousness is entirely unrelated legally and factually to the "aggregation" question raised in the *Pavement* case. In that suit the Petitioner alleged that the lower court failed to give proper consideration and weight to the matter of unpatentable aggregation under the authority of *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545 (1937). No question of aggregation in the sense of the *Lincoln Engineering* case or otherwise has been placed in issue in this suit, and the Court of Appeals made no reference to this question in its opinion below because it was not in issue.

Petitioner herein also contends that there is a conflict between panels of the Court of Appeals for the Fourth Circuit as to the soundness of the decision of the Court of Claims in *Blumcraft of Pittsburgh* v. *The United States*, 372 F.2d 1014 (1967), simply because the latter was referred to in the decision of the *Pavement* case by one panel of the Court of Appeals.

However novel this theory may be, it has no bearing on the question of whether or not certiorari should be granted in this case, or on the necessity of joining it with the *Pavement* case for hearing and consideration before this Court. In *Pavement Salvage Co., Inc.* v. *Anderson's-Black Rock, Inc.*, 404 F.2d 450 (4th Cir. 1968), the Fourth Circuit Court of Appeals referred to secondary considerations such as commercial success and long felt need as being helpful in shedding light on the origin of an invention. These sub-tests were noted as being useful in conjunction with the major guidelines of *Graham* for determining obviousness or non-obviousness of an invention. *Blumcraft of*

Pittsburgh v. *The United States*, supra, 372 F.2d 1014 (1967), was simply cited by the Court of Appeals as being one case among many which had previously made reference to the value of sub-tests for resolving validity of a patent where patentability was in doubt.

The Court of Appeals, in its decision in this suit below pursued the *Graham* guidelines virtually ad verbum, including those relating to secondary considerations such as commercial success and long felt need. However, after giving these secondary matters all the weight to which they were entitled in light of the evidence, the Court concluded that secondary factors simply could not breathe life into what were clearly dead patents.

Comparison of the decisions of the Fourth Circuit in the *Pavement* case and in this case clearly shows that the *Graham* guidelines in their entireties were applied by both panels in reaching the final conclusions expressed. The only question here presented is whether the right decision was reached under the evidence presented by Respondents.

Opinion of the Court of Appeals

Although the considerations discussed above are dispositive of the real issues presented by this Petition, the generalized attack by Petitioner on the soundness of the decision by the Court of Appeals requires factual response.

The structure of the mechanical patent is nothing more than a simple, two jaw device clamped to the rail by a bolt (as in a common vise bolted to a post) for supporting the rail offset from the post. Everything about this structure is completely obvious.

Blum himself described his two piece clamp as gripping the handrail in the manner of a vise. And a vise it is. There is no need to go further than a common ordinary vise found on the work benches of every machine or

basement workshop to find the basic concept of the Blum structure. In a vise, one of the clamping elements is secured to the bench while the other clamp element is joined to the first by a threaded bolt member. A work piece can thus be clamped between the jaw elements and held spaced from the support for the jaws.

Posts and handrails were ancient when Blum filed his patent application on the handrail assembly of his mechanical patent. Offsetting of the handrail from the post was not new. This is particularly confirmed by the fact that the Blum design patent is prior art to the Blum mechanical patent. While the design patent did not use a two piece clamp with notches for gripping the dovetail of the handrail, that specific concept had been available to the art since at least 1875 as shown in the Hardy patent No. 163,996. A two piece clamp with V-notches complementally gripping the dovetail base of a rail was also clearly shown in the 1915 McNeil patent No. 1,165,195.

Following the *Graham* guidelines, the Court of Appeals recorded in its opinion the differences which existed between the prior art and the assembly of the mechanical patent. These primarily included Hardy's mounting of the handrail directly above the post rather than to one side, and McNeil's use of the same old clamping principle for railroad rails. The court correctly held that because the Blum structure and that of McNeil are both "simple devices employing the same universally known principles of mechanics, McNeil's patent is pertinent prior art and supports our conclusion that Blum's device was obvious. *Mast Foos & Co.* v. *Stover Mfg. Co.*, 177 U.S. 485, 493 (1900); *Knapp* v. *Morss*, 150 U.S. 221, 226 (1893); *Skee-Trainer, Inc.* v. *Garelick Mfg. Co.*, 361 F.2d 895, 898 (8th Cir. 1966)." (Pet. A. p. 54a).

Noting that the highly developed state of the prior art confirmed that designers in the field were highly skilled, the Court of Appeals properly concluded that the differences between such prior art and the structure of the mechanical patent in suit were not sufficient to establish non-obviousness. The Court had no alternative other than to hold that in view of the common place ideas of supporting handrails offset from posts and providing vise type clamps for the rails "It was within the skill of an ordinary mechanic to attach a vise-like clamp to a post in any number of positions by any number of means." (Pet. A. p. 53a).

Blumcraft found it necessary to resort to an argument that such secondary factors as flexibility and rigidity so that the railing could be assembled at the job site to meet existing conditions supported patentability. But even these features were old in the prior art, as found for example in the commercial structure of the design patent which was prior art to the mechanical patent.

The Court of Appeals treated invalidity of the design patent with equal precision. Acknowledging that the prior art did not disclose a handrail of the exact form detailed in the patent drawing, the Court said that in order to be patentable, the "design must be more than novel". The applicability of this principle to design patents has long been understood and accepted. Cf. *Smith* v. *Whitman Saddle Co.*, 148 U.S. 674 (1893).

With the background of Blumcraft's insistence that the downturned upper rail, bullet feet, serrated shanks and specific shapes of the posts and handrails were to be ignored in considering its design patent, the invention, if any, of the design patent, *as asserted by Blumcraft,* became limited to the provision of a plurality of handrails supported away from the posts through use of L-shaped, relatively inconspicuous brackets. Under such definition

by Blumcraft of the nature and scope of its alleged invention, the Court necessarily found the patent invalid as clearly lacking invention over the prior art relied upon by Respondents.

Since, at the time Blum did the work which led to filing of his application for design patent, the railing art was highly developed, Petitioner's persistent plea that Blum was the first to provide a handrail compatible with modern architecture (Pet. p. 7) is utter nonsense. Architects had been designing handrails compatible with modern architecture for years before Blum's railing. Many had handrails offset from the posts.

In its review of the prior art, the Court below noted that multiple parallel rails offset from their supporting posts was old.[1] L-shaped brackets for supporting handrails were also well known, including their use as means for mounting a plurality of rails away from the posts therefore.[2] Even the specific shapes of the handrails and posts were shown to be old.

The crux of the differences between the railing of the design patent and those of the prior art was summarized by the Court of Appeals as being:

> "His predecessors offset multiple rails with prominent connectors and single rails by inconspicuous connectors. Blum merely offset multiple rails by inconspicuous connectors to achieve with several rails the floating effect that had previously been imparted to a single rail." (Pet. A. p. 49a).

Since these minor differences were well within the skill of designers in this art, the Court held that the design was obvious.

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1. Def. Chart #D-2, DX 142.
2. Def. Chart #3, DX 122; Chart #D-2, DX 142.

Blumcraft attempted to negate the effect of the prior art by arguing commercial success and long felt need. Although *Graham* makes it clear that these sub-tests are not conclusive as to patentability, the more important consideration is the fact that Petitioner failed to really show commercial success or satisfaction of a long felt need.

Commercial success, if any, was primarily predicated on Blumcraft's sale of the railing components in pre-fabricated form so that they could be assembled in the field. But a design patent must concern itself with creative artistry and not mechanical features of the component parts or marketing concepts by the manufacturer.

The problem with the Petitioner's argument is well summed up by the Court of Appeals in this language:

> "To prove long-felt, unsolved need, Blumcraft says 'The need for a commercially available railing system compatible with modern architecture had existed for some time prior to the Blum invention.' This observation illustrates both Blum's success and the invalidity of his patent. There was no unsolved need for attractive modern railings. Architects were capable of supplying them through custom design. There was a need, however, for a prefabricated railing system embodying modern design. Blum met this need by adapting known custom designs to a prefabricated railing system. Blum's product enabled architects to specify the number and spacing of rails to create designs compatible with the architecture of many modern buildings. Blum's contribution to the art was not his design; this was obvious. It was his railing system which was unique. But *Blum's railing system is not the proper subject of a design patent. The statutory grant of a design patent is for appearance and not for a method of manufacture or assemblage, function or utility.*" (Citing cases and authorities) (Pet. A. p. 50a and 51a) (Emphasis added).

CONCLUSION

Petitioner's arguments merely evidence its desire to have one last review of the case on the merits, but this is clearly not a valid ground or sufficient justification for Writ of Certiorari.

The only basis in the Petition for requesting review of the mechanical patent is the allegation that the Lower Court failed to give sufficient consideration to commercial success and long-felt need. This Court has repeatedly ruled that such factors cannot breathe life into a clearly obvious, and therefore, invalid patent.

With respect to the design patent, the Lower Court properly rejected comity because of being bound to follow *Graham* v. *Deere*, supra, 383 U.S. 1 (1966). Moreover, since 35 U.S.C. 171 incorporates 35 U.S.C. 103, there is no need for this Court to again rule on the matter of obviousness as it relates to patentability.

Accordingly, Petitioner's prayer for a Writ of Certiorari to be issued to the Court of Appeals for the Fourth Circuit from its decision holding the patents invalid should be denied.

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